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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,050	12/08/2000	D. Maxwell Chickering	MS1-4174US	6216
22801	7590	07/30/2009	EXAMINER	
LEE & HAYES, PLLC			ROBINSON BOYCE, AKIBA K	
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SUITE 1400			ART UNIT	PAPER NUMBER
SPOKANE, WA 99201			3628	
			MAIL DATE	DELIVERY MODE
			07/30/2009	PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

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8 *Ex parte* MAXWELL D. CHICKERING and DAVID E. HECKERMAN

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11 Appeal 2008-004115
12 Application 09/681,050
13 Technology Center 3600

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16 Decided:¹ July 30, 2009

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19 *Before:* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
20 JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

21
22 CRAWFORD, *Administrative Patent Judge.*

23
24
25 DECISION ON APPEAL

26
27 STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection
2 of claims 1 to 11 and 13 to 30. We have jurisdiction under 35 U.S.C. § 6(b)
3 (2002).

4 Appellants invented a decision theoretic approach for targeting
5 solicitation. (Specification 1).

6 Claim 1 under appeal reads as follows:

7 1. A computer-implemented method for
8 soliciting a sub-population of a population,
9 comprising:

10 employing a computer-implemented
11 component to identify the sub-population to solicit
12 and a non-solicited sub-population by using a
13 computer-implemented decision theoretic model,
14 the decision theoretic model constructed to
15 maximize an expected increase in profits;

16 setting a solicitation variable to a first value
17 for each of a plurality of members of the
18 solicitation sub-population and to a second value
19 for each of a plurality of members of the non-
20 solicitation sub-population;

21 soliciting the sub-population identified to
22 solicit; and

23 setting a purchase variable to a first value
24 for each of the plurality of members of the
25 solicitation and the non-solicitation sub-population
26 that made a purchase and to a second value for
27 each of the plurality of members of the solicitation
28 and the non-solicitation sub-populations that did
29 not make the purchase.

31 The prior art relied upon by the Examiner in rejecting the claims on
32 appeal is:

33	Kohavi	US 6,182,058 B1	Jan. 30, 2001
34	Bibelnieks	US 2003/0208402 A1	Nov. 6, 2003

1 The Examiner rejected claims 1, 8 to 10, and 28 under 35 U.S.C. §
2 102(e) as being anticipated by Bibelnieks.

3 The Examiner rejected claims 2 to 7, 11, 13 to 27, 29, and 30 under 35
4 U.S.C. § 103(a) as being unpatentable over Bibelnieks in view of Kohavi.

5

6 ISSUES

7 Have Appellants shown that the Examiner erred in finding that
8 Bibelnieks discloses setting a purchase variable to a first value for each of
9 the plurality of members of the non-solicitation sub-population that made a
10 purchase and to a second valued for each of the plurality of members of the
11 non-solicitation sub-population that did not make a purchase? The issue
12 turns on whether Bibelnieks discloses a non-solicitation sub-population.

13

14 FINDINGS OF FACT

15 Bibelnieks discloses a method for solicitation of a population that
16 includes a cannibalization analysis. Cannibalization is the expected impact
17 on the promotion stream reward of one promotion event due to the
18 implementation of another promotion event [0037]. As depicted in Figure 6,
19 a promotion 1 begins before promotions 2 and 3. Promotions 2 and 3 lessen
20 the impact of promotion 1 [0053]. The effects of cannibalization on
21 promotion 1 can be seen in Figure 6. Promotions 2 and 3 saturate the
22 customer with promotional activity because they overlap with promotion 1
23 in the shaded area 60 [0053].

24 In the cannibalization, analysis S is used to represent the set of people
25 who received promotions I and J. I(S) represents the total sales from
26 promotion I and J(S) represents the total sales from promotion J. A(J)

1 represents the sum of sales of customers in the set S of a product from
2 promotion J which was also available under promotion I. From the
3 perspective of those who received promotion J, those that received both
4 promotions I and J can be considered the solicitation sub-population. Those
5 that only received promotion I can be considered the non-solicitation
6 promotion group in regards to the J promotion. In other words those that did
7 not receive promotion J are in a non-solicitation promotion group for
8 promotion J. The analysis determines the maximum sales that promotion I
9 would have had to customers if promotion J had not been mailed or the sales
10 to the group that did not get the J promotion [0062]. As such, the analysis
11 determines a purchase variable for members of a non-solicitation of
12 promotion J sub-population.

13

14 PRINCIPLES OF LAW

15 An invention is not patentable under 35 U.S.C. § 103 if it is obvious.
16 *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). The facts
17 underlying an obviousness inquiry include: Under § 103, the scope and
18 content of the prior art are to be determined; differences between the prior
19 art and the claims at issue are to be ascertained; and the level of ordinary
20 skill in the pertinent art resolved. Against this background the obviousness
21 or nonobviousness of the subject matter is determined. Such secondary
22 considerations as commercial success, long felt but unsolved needs, failure
23 of others, etc., might be utilized to give light to the circumstances
24 surrounding the origin of the subject matter sought to be patented. *Graham*
25 *v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In addressing the findings of
26 fact, “[t]he combination of familiar elements according to known methods is

1 likely to be obvious when it does no more than yield predictable results.”

2 *KSR* at 416. As explained in *KSR*:

3 If a person of ordinary skill can implement a
4 predictable variation, § 103 likely bars its
5 patentability. For the same reason, if a technique
6 has been used to improve one device, and a person
7 of ordinary skill in the art would recognize that it
8 would improve similar devices in the same way,
9 using the technique is obvious unless its actual
10 application is beyond his or her skill. *Sakraida*
11 and *Anderson's-Black Rock* are illustrative - a court
12 must ask whether the improvement is more than
13 the predictable use of prior art elements according
14 to their established functions.

15 *KSR* at 417.

16 A prior art reference is analyzed from the vantage point of all that it
17 teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009
18 (CCPA 1968) (“The use of patents as references is not limited to what the
19 patentees describe as their own inventions or to the problems with which
20 they are concerned. They are part of the literature of the art, relevant for all
21 they contain.”). Furthermore, “[a] person of ordinary skill is also a person of
22 ordinary creativity, not an automaton.” *KSR* at 421.

23 On appeal, Applicants bear the burden of showing that the Examiner
24 has not established a legally sufficient basis for combining the teachings of
25 the prior art. Applicants may sustain its burden by showing that where the
26 Examiner relies on a combination of disclosures, the Examiner failed to
27 provide sufficient evidence to show that one having ordinary skill in the art
28 would have done what Applicants did. *United States v. Adams*, 383 U.S. 39,
29 52 (1966).

30

ANALYSIS

We are not persuaded of error on the part of the Examiner by Appellants' argument that Bibelnieks does not disclose setting a purchase value to a first value for each of the plurality of members of the solicitation and the non-solicitation population that made a purchase and to a second value for each of the plurality of members of the solicitation and the non-solicitation sub-populations that did not make the purchase. Bibelnieks discloses that two promotions are sent out, promotion I and promotion J. Promotion I is sent out earlier in time than promotion J. Each of the promotions can be for the same product. All members receive the promotion I. A subset of members also received the J promotion. As such, at the time that the promotion J is sent out, a set of members are sent the promotion J and a set of members are not sent the promotion J. As such, at the time of the promotion J and in regard to promotion J, there is a promotion receiving group (solicitation group) and a promotion non-receiving group (non-solicitation group). Bibelnieks determines the total sales of the product to the members who did not receive the J promotion thereby determining the sales of the product of those that are in the non-solicitation group.

19 In view of the foregoing, we will sustain the Examiner's rejection of
20 claim 1 under 35 U.S.C. § 102(e) as being anticipated by Bibelnieks. We
21 will also sustain the rejection as it is directed to claims 8 to 10 and 28
22 because the Appellants have not argued the separate patentability of these
23 claims.

24 We will also sustain the Examiner’s rejection of claims 2 to 7, 11, 13
25 to 27, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over
26 Bibelnieks in view of Kohavi because the Appellants rely on the arguments

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1 made in regard to the anticipation rejection based on Bibelnieks and add that
2 Kohavi does not cure the deficiencies of Bibelnieks. However, we found
3 that Bibelnieks did disclose the steps found missing by Appellants.

4

5 CONCLUSION OF LAW

6 On the record before us, Appellants have not shown error on the part
7 of the Examiner.

8

9 DECISION

10 The decision of the Examiner is affirmed.

11 No time period for taking any subsequent action in connection with
12 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2008).

13

14 AFFIRMED

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